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In re Application of :
WU, et al. :
U.S. Application No.: 10/531,147 : DECISION ON PETITION
PCT No.: PCT/US03/29126 :
Int. Filing Date: 15 October 2003 : UNDER 37 CFR 1.48(b)
Priority Date: 18 October 2002 :
Attorney Docket No.: P5102R1 :
For: COMPOSITIONS AND METHODS FOR THE :
DIAGNOSIS AND TREATMENT OF TUMOR :

This decision is in response to applicant's "Petition to Correct Inventorship Under 37 C.F.R. § 1.48(b)" filed 27 December 2005.

BACKGROUND

On 15 October 2003, applicant filed international application PCT/US03/29126, which claimed priority of an earlier U.S. application filed 18 October 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was set to expire 30 months from the priority date, 18 April 2005.

On 12 April 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an Application Data Sheet.

On 24 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b). The notification set a two month time limit in which to respond. Applicant was advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 27 December 2005, applicant filed the present petition to delete Yan Zhou as a named inventor and a declaration signed by Thomas D. Wu.

DISCUSSION

As to applicant's petition under 37 CFR 1.48(b) to delete inventor Zhou because the "invention(s) made by this person is no longer being claimed in the above captioned patent application", the present national stage application must first be executed by all the named

inventors. The filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for a patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the REQUEST form. The REQUEST indicated Thomas D. Wu and Yan Zhou as applicants/inventors for the United States of America.

37 CFR 1.48(f)(1), by its terms, applies only to a non-provisional application filed under 37 CFR 1.53(b). (See also, 37 CFR 1.9(a)(3)). A national application resulting from an international application entering the national stage under 37 U.S.C. 371 is not an application filed under 37 CFR 1.53(b), but an application that has entered that national stage under 37 CFR 1.494 or 1.495.

Accordingly, the requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors.

CONCLUSION

For the reasons above, the request to correct inventorship under 37 CFR 1.48(b) will be held in abeyance pending completion of all requirements under 35 U.S.C. 371(c).

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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